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IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1957.

No. 673.

MINNESOTA MINING AND MANUFACTURING COMPANY,
Petitioner,

vs.

SEARS ROEBUCK AND COMPANY and THE PLYMOUTH RUBBER COMPANY, INC.,
Respondents.

PETITION FOR REHEARING.

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PETITION FOR REHEARING.

Foreword.

On January 27, 1958, this Court denied the Petition for Writ of Certiorari in this case. The reasons submitted for granting the petition have been reviewed in detail, and it appears that a basic question of Federal law concerning the application and conclusiveness of Rule 52 (a) of the Rules of Civil Procedure raised by the court below and obvious on the face of the opinion, while indicated, was not presented for consideration. There also exists an additional special and important reason comprising multiple litigation on the Oace patent. These reasons compel the presentation of this petition for rehearing, and follow in reverse order.

I. This Court Can and Should Authoritatively Determine the Issues Surrounding the Oace Patent to Resolve Multiple Pending Litigation.

Rule 19 of the Revised Rules of this Court states that "A review on writ of certiorari is not a matter of right, but of **sound judicial discretion**, and will be granted only where there are **special** and **important reasons** therefor. * * *" (Emphasis added.) Several reasons considered "special and important" follow this quoted portion, but the rule prefaces the same with the significant statement that the enumerated reasons **neither control** nor **fully measure** the Court's discretion.

It is earnestly submitted that a special and important reason exists in this case, which, while not in the enumerated group, warrants granting this petition and allowing certiorari. The Oace patent is presently involved in a number of suits in various Circuits. It is the basis of six unadjudicated actions, namely:

Minnesota Mining & Mfg. Co. v. Technical Tape Corp. et al., C. A. 54 C. 1116, Northern District of Illinois, Eastern Division;

Minnesota Mining & Mfg. Co. v. Plymouth Rubber Co., Inc. et al., C. A. 54 C. 1115, Northern District of Illinois, Eastern Division;

Minnesota Mining & Mfg. Co. v. Permacel-LePage's, Inc., C. A. 57 C. 1888, Northern District of Illinois, Eastern Division;

Minnesota Mining & Mfg. Co. v. Superior Insulating Tape Co., C. A. 9907 (2), Eastern District of Missouri, Eastern Division;

Minnesota Mining & Mfg. Co. v. United States Rubber Co. et al., C. A. 336 R, Middle District of North Carolina;

Minnesota Mining & Mfg. Co. v. The Goodyear Tire & Rubber Co., Inc. et al., C. A. 1026-G, Middle District of North Carolina.

It stands adjudicated infringed in a judgment in the case of **Minnesota Mining & Manufacturing Company v. Pine State Electric Supply Co., Inc., et al.**, United States District Court for the Middle District of North Carolina, Civil Action No. 879-G, which was not appealed.

This prospective extended litigation involving the same or similar issues as here comprises a special and important reason for the exercise of this Court's discretion to grant certiorari and to authoritatively determine the scope of the Oace patent and other issues here. Both public and private interests are involved, the latter being secondary to the former. Action by this Court now to resolve the contested questions will avoid the extensive litigation. Such action will be in the public interest, will conserve the time of the courts, and will insure uniformity of decision concerning the same subject matter.

It is respectfully urged that this Court take jurisdiction **now** and authoritatively determine the issues surrounding the Oace patent, thereby terminating the prospective extended litigation, which will be in the interests of the courts, the public, and the litigants.

II. An Important Question of Federal Law Has Been Decided in Conflict With Decisions of This Court.

Rule 52 (a) of the Rules of Civil Procedure provides in the pertinent portion:

> "* * * Findings of fact shall not be set aside **unless clearly erroneous**, and due regard shall be given to the opportunity of the trial court to judge of the **credibility** of the witnesses * * *." (Emphasis ours.)

The Rules of Federal Procedure are statutorily authorized and have the effect of statute.

What does the quoted portion of Rule 52 (a) mean? This Court has spoken authoritatively upon its binding effect on Appellate Courts. In **United States v. National**

Association of Real Estate Boards, 339 U. S. 485, Mr. Justice Douglas for this Court said (p. 495):

> "It is not enough that we might give the facts another construction * * *."

In **U. S. v. Yellow Cab Co.,** 338 U. S. 388, Mr. Justice Jackson pointed out that where the evidence would support a conclusion either way (p. 342):

> "* * * Such a choice between two permissible views of the weight of evidence is not 'clearly erroneous' * * *."

In **Graver Tank & Mfg. Co. v. Linde Air Products Co.,** 336 U. S. 271, 275, 93 L. ed. 672, 676 (1949), Mr. Justice Jackson said (p. 275):

> "The rule requires that an appellate court make allowance for the advantages possessed by the trial court in appraising the significance of conflicting testimony and reverse only 'clearly erroneous' findings. * * *"

It is clear from its opinion that the Court below as a matter of law has misapprehended the mandate of Rule 52 (a) as construed by this Court and as followed by most other Circuit Courts of Appeal. The trial court, on a record consisting of over twenty-five hundred pages and including over two hundred exhibits, made inter alia specific fact findings in support of its ultimate fact findings of infringement after analyzing a **mass** of **conflicting** evidence. Reference is made to Findings of Fact Nos. 31, 46 and 51, quoted in the footnote.* The Court of Appeals, as its

* "31. The patent in suit teaches persons skilled in the art that ethyl acrylate polymer may be used as the plasticizer for the film backing of the tape of the patent. The patent discloses a plasticizing system which is satisfied by one or more ingredients of plasticizing material. There is in evidence a roll of pressure-sensitive insulating tape wherein the film backing is 100 parts of VYNS vinyl chloride

opinion shows, **re-evaluated** and **reweighed** critical portions of the evidence, **judging credibility** of witnesses without benefit of observation and without opportunity to examine them, and chose, for example, to believe DeBell, respondent's witness, over the contrary testimony of Tierney and Oace, petitioner's witnesses, that had been believed by the trial judge, and to believe a single conclusion of one Bergen over an accumulation of contrary evidence credited by the trial judge. On the critical fact issue of infringement, the court below set aside the trial court's finding on the statement: "Our examination of the record convinces us that the findings on which this conclusion is largely based are not in accord with the great weight of the evidence."

The Court below **did** give the facts another construction, contrary to this Court's admonition in **United States v. National Association of Real Estate Boards, supra**, it **did** make a choice different from the trial court in respect to the weight of the evidence contrary to this Court's clear statements in **U. S. v. Yellow Cab Co., supra**, and did judge

credibility of witnesses, contrary to this Court's statement in **Graver v. Linde, supra.**

That the correction of the misapprehension of the Court below of Rule 52 (a) is of great public importance becomes strikingly clear when decisions of other Courts of Appeal are reviewed. Most follow the above quoted directives of this Court, while at least one other is to the contrary. Litigants, each of whom is a part of the public alluded to so often, are entitled to uniformity of legal construction of Rule 52 (a), one of the most important facets of the Rules of Civil Procedure. To know how this rule is interpreted is essential to proper preparation for trial.

It is not possible to review all pertinent late decisions of the Courts of Appeals, but the following illustrate the point:

1. Decisions from the First, Fifth and Seventh Circuits following this Court's directives in respect to Rule 52 (a):

In **Marks v. Polaroid Corporation,** 237 F. (2d) 428 (C. A. 1—1956), Judge Woodbury said (p. 435):

> "This brings us to the question of infringement which again does not call for extended discussion. The District Court found that the defendant Depix Corporation used substantially Land's materials and process to produce substantially Land's product. Its finding is based on the testimony of expert witnesses called by Polaroid who the court below found had made exhaustive scientific tests of Depix' material, and on moving pictures of Depix process shown in court. To be sure this evidence was contradicted by experts called by the plaintiff. Nevertheless the court below was certainly entitled to give controlling significance to the defendant's evidence. Further discussion would serve no purpose. It will be enough to say that the District Court's finding of infringement, rest-

ing as it does on substantial evidence which the court below found convincing, is not open to successful attack on appeal."

In **Georgia Kaolin Company v. Thiele Kaolin Company**, 228 F. (2d) 267 (C. A. 5—1955), Judge Rives said (p. 275):

"* * * In a patent case where the controlling facts are without significant dispute, infringement may conceivably become a question of law for an appellate court, but where, as here, the testimony is in sharp conflict on material particulars, infringement must of necessity be viewed as a question of fact to be resolved by the fact finder on a credibility basis like any other factual issue. See Fritz W. Glitsch & Sons, Inc., v. Wyatt Metal & Boiler Works, 5 Cir., 224 F. 2d 331. Though an occasional injustice may result, we think it by far the better practice in patent litigation, as elsewhere, for the essential facts to be resolved at the fact-finding level, than for appellate courts without clear warrant to usurp the fact-finding function."

In **Weller Manufacturing Company v. Wen Products, Inc.**, 231 F. (2d) 795 (C. A. 7—1956), Judge Lindley said (p. 797):

"* * * We say this, because, inasmuch as Judge Barnes had before him in a 9 days' trial, the extended controversial testimony of expert witnesses on behalf of the respective parties, as well as that of the patentee, certain witnesses skilled in technical learning and other witnesses concerning certain pertinent factual matters, in addition to extensive documentary evidence, models and other physical exhibits, the rule we announced in Hazeltine Research, Inc., v. Admiral Corp., 7 Cir., 183 F. 2d 953, certiorari denied 340 U. S. 896, 71 S. Ct. 239, 95 L. Ed. 650, is applicable to the present situation. In other words, just as, in that case, we felt that, in view of the conflicting testimony of expert witnesses and other controversial testimony,

we were not at liberty to deny the applicability of Rule 52 (a) of the Federal Rules of Civil Procedure, 28 U. S. C., so here, after an examination of the record and consideration of the conflicts between the witnesses, we have no right, we think, **to redetermine the findings of fact of the District Court** or to say, as a matter of law, that they are clearly erroneous. * * *" (Emphasis added.)

In **Simmons Co. v. A. Brandwein & Co.**, 115 U. S. P. Q. 307 (C. A. 7—1957), Judge Major said (p. 311):

"We have given careful consideration to the contentions pro and con regarding such findings, together with the evidence, oral and documentary, and come to the conclusion that they are justified by the record. Certainly we are not prepared to hold that they are 'clearly erroneous' under Rule 52 (a) of the Federal Rules of Civil Procedure.

"Plaintiff apparently ignores this rule applicable upon appellate review and argues that the findings are 'contrary to the weight of the evidence.' * * *"

In **Eicks v. Houghton**, 248 F. 2d 394 (C. A. 7—1957), Judge Hastings said (pp. 396, 397):

"This being a trial without a jury and the court having found the facts specially, Rule 52 (a) of the Federal Rules of Civil Procedure, 28 U. S. C. A., is applicable * * *."

* * * * * * *

"This court recently in the case of Lichter v. Goss, 7 Cir., 1956, 232 F. 2d 715, 719, reaffirmed its holding in West v. Schwarz, 7 Cir., 1950, 182 F. 2d 721, 722, where we said:

"'However, it is not the functions of this court to pass upon or consider de novo the evidence received upon the trial, Webb v. Frisch, 7 Cir., 111 F. 2d 887, **nor to weigh the controverted evidence**

> Smith v. American Transit Lines, Inc., 7 Cir., 163 F. 2d 1014. Our duty is merely to ascertain whether the record discloses substantial evidence to sustain the findings of the trial court. Findings of fact shall not be set aside unless clearly erroneous, giving due regard to the opportunity of the trial court to judge of the credibility of the witnesses.' (Emphasis added.)

"Here the evidence was largely oral and the testimony of appellants cannot be reconciled with that of appellees. 'The rule requires that an appellate court make allowance for the advantages possessed by the trial court in appraising the significance of conflicting testimony and reverse only "clearly erroneous" findings.' Graver Tank & Mfg Co. v. Linde Air Products Co., 1949, 336 U. S. 271, 275."

2. Decision from the Eighth Circuit, which indicates reweighing of the evidence:

In **United States v. First Trust Co. of St. Paul**, 116 U. S. P. Q. 172 (C. A. 8—1958), Judge Vogel said (p. 175):

> "* * * We may not substitute our judgment for that of the finder of the facts. Rule 52 (a), F. R. C. P., 28 U. S. C. A."

But they he continued (pp. 175, 176):

> "* * * The view of this court on the applicability of Rule 52 (a) in nonjury or jury-waived cases is summarized in Commercial Standard Ins. Co. v. Maryland Cas. Co., 8 Cir., 1957, 248 F. 2d 412:
>
> "'In a nonjury case, this Court may not set aside a finding of fact of a trial court unless there is no substantial evidence to sustain it, **unless it is against the clear weight of the evidence**, or unless it was induced by an erroneous view of the law.' * * *" (Emphasis ours.)

* * * * * * *

> "We find that the conclusions of the trial court are based on substantial evidence, **are not against the clear weight of the evidence**, and were not induced by an erroneous view of the law." (Emphasis ours.)

This Court has spoken on Rule 52 (a), but it is obvious that it should speak again. The court below and others misapprehending this Court's directives should be instructed to the effect that the clear meaning of Rule 52 (a) does **not** permit a Court of Appeals in respect to the fact findings to **reweigh and reevaluate conflicting evidence** or to **judge of credibility of** witnesses, but that it **limits review** to a determination of whether or not there is **substantial supporting evidence**, which fully satisfies the rule.

CONCLUSION.

For the reasons stated, the Petition for Rehearing should be granted.

Respectfully submitted,

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February 19, 1958.

Certificate.

It is hereby certified that this Petition for Rehearing is presented in good faith and not for delay, and that it is restricted to substantial grounds available to Petitioner but not previously presented.

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